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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/037,630 | 01/03/2002 | J. Blake Scott | 72425.0105 | 6763 |
| 110 | 7590 | 04/06/2006 | EXAMINER | |
| DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA, PA 19103-2307 | | | MARCANTONI, PAUL D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1755 | |

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------|--|
| Office Action Summary | Application No. 10/037,630 | Applicant(s) SCOTT, J. BLAKE | |
| | Examiner Paul Marcantoni | Art Unit 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The applicants' 2/6/06 RCE and response has been considered but is not convincing.

35 USC 103:

Claims 1-20 are rejected under 35 USC 103(a) as obvious over Polston (US Patent Number 6,706,108 B2).

Response:

132 Declaration of Dallas N. Little:

It is acknowledged that the credentials of Mr. Little in the civil engineering arts are impressive and it is evident he is an expert in this art. However, the declaration is an opinion declaration and while the opinion declaration is given some weight in determination of patentability, it does not overcome the prima facie case of obviousness as set forth by the examiner. Setting forth one's opinion cannot be substituted for experimental evidence or data supporting such opinions. This experimental evidence has not been submitted by applicants to bolster their position. Also, there is no direct statement by Mr. Little that Polston would not achieve the load bearing and rutting resistance of applicants' claimed invention.

It is also the examiner's position that one of ordinary skill in the art would understand the essentials of road making which includes rutting resistance and load bearing. It would appear that one of ordinary skill in the art would have understood that he or she must design a road that can withstand heavy loads, wear and tear, and rutting resistance and control of variables such as subgrades and thickness is also within the control of that person of ordinary skill in the art making such a road.

Reply to Applicants' Arguments:

The applicants argue in boldface on page 11 of their arguments that they form their cementitious mixture into a load bearing structure. In rebuttal, a road base is a load bearing structure and also part of the makeup of a road. The applicants argue once again the resistance to rutting but have not provided experimental evidence that the prior art would not also resist rutting. It thus represents mere assertions or allegations without the benefit or basis of any experimental data or support. The applicants also focus their arguments on the "road base" of Polston versus their "road". In response, applicants' claims do not have the limitation of road so it can read upon road base as well.

The applicants state that the examiner used the word "anticipated" with respect to his 35 USC 103 rejection. This statement was in error and applicants are correct in that 35 USC 103 is not anticipation. However, even if not anticipated, overlapping ranges of amounts of the same components in the applicants' process renders their claims prima facie obvious to one of ordinary skill in the art. The applicants are also correct in that there is no new matter and this also should be disregarded because applicants have shown where they have support for their limitation with reference to rutting resistance.

This is an RCE of applicant's earlier Application No. 10/037,630. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**

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even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
Art Unit 1755